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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,484	10/07/2003	Louis Salvatore Addonisio	US0306/187	5529

23697 7590 05/01/2006

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EXAMINER	
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ART UNIT	PAPER NUMBER
2166	

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/680,484	Applicant(s) ADDONISIO ET AL.	
	Examiner Andrew Setlak	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) *16-21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15 and 22-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/27/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-15 & 22-25, drawn to an asset management and status system, classified in class 707, subclass 10.

II. Claims 16-21, drawn to a handheld scanner, classified in class 235, subclass 472.02.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because any wireless communication terminal operatively connected to the remote computing system capable of reading the asset tags could be used within the invention of group I. The subcombination has separate utility such as use in any other asset control system.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Scott Tierno on 4/14/2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-15 and 22-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: The preamble of claim 8 (line 3) states that "**at least one of the following is supported:**" yet, this recitation of structure is not followed by more than one separable limitations, since (b) is a further specification of (a) and is thus dependant on (a) the only possible combinations are (a) or (a) & (b). The language used by applicant renders limitation (b) moot since it is not required and not separable from (a). For the purposes of the remainder of the examination the examiner has assumed that the phrase "**at least one of**" has been removed from line 3 of claim 8 in order to evaluate the what the examiner believes was the applicants' intended scope.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 & 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,936,527 (henceforth referred to as Isaacman et al.).

Claim 1 is anticipated by Isaacman et al. as follows: **An asset management and status system comprising: a) a remote computing system configured with a wireless communication capability enabling, at minimum, an exchanging of information with any of a plurality of wireless data communication terminals** (figure 3, elements 21 and 14; figure 4, element 14; C8:L46-60), **each data communication terminal available for use by an individual for identifying assets and aiding in management and status determining activities** (C11:L38-43); **b) a database established and maintained on the remote computing system, and available for storing and retrieving information associated with any of a plurality of assets being managed by the asset management and status system** (C8:L22-24; C8:L56-58); **and c) the plurality of data communication terminals, with each data communication terminal structured having an equivalent of at least three communication modules supporting: i) establishing a local, short distance wireless communication link with a proximate wireless electronic device fixed to an asset of interest, such that the communication link enables a receiving by the data communication terminal of information transmitted from the electronic device, with the information including an identifying code assigned to the asset** (figure 8, transmitter[142] operating at frequency F2; C12:L23-25); **ii) receiving and processing position related information for determining a current location at which the asset and data communication terminal are located** (C12:L41-43; C11:L47-49); **iii) exchanging information with the remote computing system, including transmitting to the remote computing system the identifying code and the current location of the asset for use in accessing and updating the database established on the remote computing system** (figure 8, transmitter[138] & receiver[136]; C12:L41-43).

Claim 2 is anticipated by Isaacman et al. as in claim 1, **wherein the data communication terminal is a hand-holdable device, comprising: a) a user interface structured with an information display and a plurality of keyswitches, with the display viewable by a user and keyswitches available to the user for entering command and data information** (figure 8, keyboard[144] & display[146]; C12:L27-30; C12:L32-35); **b) a controller for controlling the operation of the wireless data communication terminal, with the user interface and keyswitches operatively coupled to the controller** (figure 8, microcontroller[134]; C12:L27-28; C12:L32-33); **c) a plurality of communication modules including a position determining module** (C11:L47-49; C12:L41-43 in which the position is determined through a communications session with the user via the user communications interface), **a local wireless transceiver module** (figure 8, transmitter[142]; C12:23-25), **and a wireless communication module** (figure 8, transmitter[138] & receiver[136]; C12:L6-12); **d) with each communication module operatively coupled to the controller such that: i) the position determining module is available to the controller for determining current location information indicating a current location of the data communication terminal and proximate items** (C11:L47-49; C12:L41-43; C12:L27-28; C12:L32-33); **ii) the local wireless transceiver module responsive to the controller such that when activated thereby, in the presence of an electronic device, an identifying code at minimum is received from the electronic device and available to the controller** (C12:L21-25); **and iii) the wireless**

communication module structured for exchanging information, including asset related information, with the remote computing system (C12:L1-15).

Claim 3 is anticipated by Isaacman et al. as in claim 2, **wherein upon receiving information including the identifying code from the electronic device, the controller is configured for activating the position determining module, determining a current location, and transmitting the identifying code and the current location information by way of the wireless communication module to the remote computing system** (C12:L25-27; C12:L41-43).

Claim 4 is anticipated by Isaacman et al. as in claim 3, **with the data communication terminal configured so that the user is prompted to authorize the transmitting of the identifying code and the current location to the remote computing system** (C8:L24-39, by storing the security credentials of authorized users as well as which users last accessed any particular record, the system must prompt a user for their credentials before allowing either read or write/update access to said record).

Claim 5 is anticipated by Isaacman et al. as in claim 3, **wherein upon receiving the information from the data communication terminal, including the identifying code and the current location, the remote computing system accesses the database and updates information stored in at least one record associated with the asset identified by the received identifying code** (C8:L31-36, at least the location and last accessed by data is updated in the database).

Claim 6 is anticipated by Isaacman et al. as in claim 5, **wherein subsequently at least a portion of a record associated with the asset identified by the identifying code is transmitted back to the data communication terminal from which the identifying code originated** (C12:L6-12; C12:L27-32, the handheld device receives information from the PC which houses the database).

Claim 7 is anticipated by Isaacman et al. as in claim 6, **wherein asset related information that is transmitted back to the data communication terminal is, at least in part, displayed for user viewing upon the display** (C12:L27-32).

Claim 8 is anticipated by Isaacman et al. as in claim 2, **wherein the data communication terminal is structured such that at least one of the following is supported: a) the user interface is employable by a user for inputting information related to the asset whose identifying code has been received via the local wireless transceiver module from an electronic device** (C12:L41-43); **and b) at least a portion of the information entered in step-a is transmitted to the remote computing system for storing in the database** (C8:L31-36).

Claim 9 is anticipated by Isaacman et al. as in claim 1, **wherein the electronic device is provided by at least one of: a) a passive RFID tag; b) an active RFID transponder; and c) a portable computing and communication device** (figure 4, RFID tags[20A, 20B & 20C]; C4:L45-48).

Claim 10 is anticipated by Isaacman et al. as in claim 9, **wherein a plurality of assets are each equipped with an electronic device, with each electronic device configured for responding to a proximate RF signal by detecting the RF signal**

and transmitting in response thereto a unique identifying code, with the identifying code received by the proximate data communication terminal producing the RF signal (C3:L17-24; C2:L6-9).

Claim 11 is anticipated by Isaacman et al. as in claim 10 in view of the paper *An Overview of Back Scattered Radio Frequency Identification System (RFID)* (henceforth referred to as Rao), **wherein the detecting of the RF signal by the electronic device results in a backscattering modulation being produced by the electronic device, which is employed for transmitting the identifying code to the data communication terminal** (Isaacman et al.: C4:L45-46, in view of Rao: Abstract, it becomes clear that production of a backscattered modulated wave is an inherent property of an excited RFID tag [**the electronic device**]).

Claim 12 is anticipated by Isaacman et al. as follows, **A distributed asset management and status system enabling a plurality of distributed assets to be inventoried, managed, and tracked such that a database, containing at least one record for each asset, can be established, maintained and updated, as an asset information repository that is available for remote accessing each time an asset is identified, the asset management and status system comprising: a) a plurality of data communication terminals structured with a user interface and a multi-function communications capability, the data communication terminal configured for: i) establishing a communication link with at least one proximate electronic device of an asset for exchanging information therewith, including a receiving by the data communication terminal of information including a unique identifying**

code transmitted by a respective proximate electronic device (C3:L17-24; C2:L6-9); **ii) receiving and processing position information enabling a determining of a current location at which the asset and data communication terminal are located** (C12:L41-43; C11:L47-49); **and iii) transmitting information, including at least the identifying code and the associated current location information to a remote computing system** (figure 8, transmitter[138] & receiver[136]; C12:L41-43); **b) the remote computing system, providing access to the database housing the asset related information in the form of at least one record for each asset, with the database established, maintained and updated, for accessing by a user utilizing one of the wireless data communication terminals for gaining access to information related to one or more assets of interest** (C8:L22-24; C8:L56-58); **c) a plurality of the electronic devices, with each electronic device associated with an asset by fixing thereto by way of a selected means, each electronic device configured having a unique and readable identifying code** (C12:L21-25; C6:L62-65); **and d) means for enabling the exchanging of information between the data communication terminal and each of: i) the electronic device** (figure 8, transmitter[142] operating at frequency F2; C12:L23-25); **ii) a position determining system** (C12:L41-43; C11:L47-49); **and iii) the remote computing system** (figure 8, transmitter[138] & receiver[136]; C12:L41-43).

Claim 13 is anticipated by Isaacman et al. as in claim 12, **wherein each electronic device is provided by at least one of: a) a passive RFID tag; b) an**

active RFID transponder; and c) a portable computing and communication device (figure 4, RFID tags[20A, 20B & 20C]; C4:L45-48).

Claim 14 is anticipated by Isaacman et al. as in claim 12, **wherein information is also transmitted from the data communication terminal to the electronic device for storage thereby** (C11:L1-7; C11:L33-34; C10;L63-65).

Claim 15 is anticipated by Isaacman et al. as in claim 14, **wherein the information transmitted to the electronic device, at least in part, originated from the remote computing system** (C11:L1-7, the host transceiver and the PC comprise the remote computing system of the instant application).

Claim 22 is anticipated by Isaacman et al. as follows, **A method of monitoring a plurality of distributed assets and maintaining a database of information associated with the assets, with each asset equipped with an electronic identification device having a unique identifying code contained therein, the method comprising the steps of: a) radiating an RF signal for detection by at least one proximate wireless electronic identification device of an asset** (figure 4, RFID tags[20A, 20B & 20C]; C4:L45-48); **b) receiving information from an electronic identification device radiated by the RF signal, with the information including at minimum an identifying code** (C3:L17-24; C2:L6-9); **c) determining a current location** (C12:L41-43; C11:L47-49); **and d) transmitting information, including the identifying code and the current location, to a remote computing system for use in accessing and updating a database of asset related information** (figure 8, transmitter[138] & receiver[136]; C12:L41-43).

Claim 23 is anticipated by Isaacman et al. as in claim 22, **wherein after the transmitting step, additional steps include: a) using the information received by the remote computing system, including the identifying code, and accessing at least one record of the database utilizing the identifying code** (figure 8, transmitter[138] & receiver[136]; C12:L41-43); **b) updating location information indicating a current location stored within the record accessed** (figure 8, transmitter[138] & receiver[136]; C12:L41-43).

Claim 24 is anticipated by Isaacman et al. as in claim 23, **wherein an additional step is included of transmitting at least a portion of the accessed record back to the data communication terminal from which the identifying code was originally transmitted** (C12:L6-12; C12:L27-32, the handheld device receives information from the PC which houses the database).

Claim 25 is anticipated by Isaacman et al. as follows, **An asset management and status system providing a computing system configured with a wireless communication capability for supporting an exchanging of information with any of a plurality of wireless data communication terminals remotely located from the computing system, with the computing system arranged for receiving information such as an identifying code of an asset from each data communication terminal, as well as information indicating a current location of the asset, for use in updating and maintaining a database of asset related records, the computing system comprising: a) the wireless communication capability, wherein information can be exchanged with each of the data communication terminals** (figure 3, elements 21 and 14; figure 4, element 14; C8:L46-60); **and b) the database established and maintained on the remote computing system, and available for storing and retrieving information associated with any of a plurality of assets being managed by the asset management and status system** (C8:L22-24; C8:L56-58); **c) with records of the database accessed, at least in part, utilizing an identifying code received via the wireless communication capability, and additionally storing, at minimum, the current location for a respective asset associated with the accessed record** (figure 8, transmitter[138] & receiver[136]; C12:L41-43).

Information Disclosure Statement

Applicants' Information Disclosure Statement, filed on 10/27/2003 has been received, entered into the record, and considered. See attached PTO-1449 forms.

Conclusion

The prior art made record of on form PTO-892 and not relied upon is considered pertinent to the applicants' disclosure.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Setlak whose telephone number is (571) 272-4060. The examiner can normally be reached on M-F 10:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Setlak
Patent Examiner
3/22/2006

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